

Remarks

Claims 1-17 and 19-28 stand rejected under 35 U.S.C. 102(e) as anticipated by or in the alternative, under 35 U.S.C. 103(c) as allegedly obvious over U.S. Patent 6,598,923 to Stol et al ("the '923 patent"). Claims 29-35 are allowable subject matter. Claim 18 stands objected to as being dependent on a rejected base claim, but has been deemed allowable by the Examiner if rewritten in independent form to include all the limitations of the rejected base claim. Although applicants acknowledge the allowable subject matter indicated by the Examiner, applicants at this time wish to secure patentability of each of the outstanding claims.

Applicants submit that Claims 1-17 and 19-28 may not be rejected over the '923 patent under §102(e) or §103(c), since the '923 patent and the present application were commonly owned at the time the invention was made. In so far as the §102(e) rejection is concerned, applicants submit that the statute under 35 U.S.C. §102(e) states that:

A person shall be entitled to a patent unless— the invention was described in— (1) an application for patent filed by another in the United States before the invention by the applicant for patent....; or (2) a patent is granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

Referring to §2137.01 of the MPEP, a joint application or patent and a sole application or patent by one of the joint inventors are [by] different legal entities and accordingly, the issuance of the earlier filed application as a patent becomes a reference for everything it discloses, except where:

1) The claimed invention in a later filed application is entitled to the benefit of an earlier filed application under 35 U.S.C. §120 (an overlap of the inventors rather than identical inventive entity is permissible). In this situation a rejection under 35 U.S.C. §102(c) is precluded. *See Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 28115 USPQ2d 1816, 1818 (Fed.Cir. 1988); and

2) The subject matter developed by another person and the claimed subject matter were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants note, that the present application is a continuation-in-part of application no. 10/108,040, which is a continuation-in-part of application no. 09/990,807. Application no. 09/990,807 issued into the '923 patent, wherein the '923 patent and the present patent share an overlap in inventorship. Therefore, since the '923 patent and the present application share an overlap in inventorship and the present application is entitled to the benefit of the '923 patent, under 35 U.S.C. §120, the '923 patent is not prior art by another, as required under §102(e). Accordingly, applicants respectfully request that the rejection under 35 U.S.C. §102(e) be withdrawn.

Insofar as the §103 rejection is concerned, applicants submit that the statute under 35 U.S.C. §103(c) states that:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants submit that the '923 patent was applied by the Examiner as prior art under 35 U.S.C. §103 via 35 U.S.C. §102(e). Applicants note in this regard that MPEP §706.02(k) states that:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

This change to 35 U.S.C. §103 is applicable to all utility, design, and plant applications filed on or after November 29, 1999. Applicants note that the present application was filed February 2, 2004; therefore the present application is entitled to the above change in 35 U.S.C. §103.

In view of this, and the fact the present application and the '923 patent "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person", the '923 patent is disqualified as a reference under 35 U.S.C. §103(c).

To evidence that the instant application and the '923 patent "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person", the assignment document of the present application (recordation date February 2, 2004 at Reel 014966, Frame 0764) was compared with the recorded assignment of the '923 patent (recordation date February 11, 2002 at Reel 012610, Frame 0918). In both instances, the inventors conveyed their entire interest to Alcoa Inc.; therefore establishing common ownership between the instant application and the '923

patent. In view of the above information, the '923 patent is disqualified as art. Thus, the rejection under 35 U.S.C. §103(c) has been obviated; therefore reconsideration and withdrawal thereof is respectfully requested.

It is respectfully submitted that the present application is in condition for allowance. If the Examiner would like to suggest changes of a formal nature to place this application in better condition for allowance, a telephone call to Applicants' undersigned attorney would be appreciated.

Respectfully submitted,



Harry A. Hild, Jr., Esq.

Attorney for Applicants

Reg. No. 51,803

Tele. No. 724-337-4726

08840

08840

PATENT TRADEMARK OFFICE